

REMARKS**REJECTIONS UNDER 35 U.S.C. § 102(b)**

The Examiner has rejected claims 35-40 under 35 U.S.C. § 102(B) as being anticipated by U.S. Patent No. 5,674,951 to Hargis et al. The reasons for the Examiner's rejections are not fully understood and therefore Applicants have opted to reproduce the Examiner's comments:

Independent claims 35 is a product-by-process. Applicants' argument is that claim 35 discloses: "a block copolymer is formed by polymerizing oxetane monomer in the presence of a hydroxyl-terminated hydrocarbon polymer." A plurality of polymerizable oxetane monomer forms an oligomer or polymer. Therefore, a first block polymer is readable as an oligomer or polymer. . . . The oxetane monomers are readable in Applicants' claims, column 2, line 20. Any polyhydric alcohol having more than 2 hydroxyl groups including polybutadienes containing terminal hydroxyl groups are readable in the present claims, column 3, lines 47-49. Any linkage would be expected in the present claim 35.

Because Applicants maintain that claims 35-40 are patentable over the cited prior art, reconsideration is respectfully requested.

To begin with, the Examiner's statement "any linkage would be expected in the present claim 35" defies the Applicants' previous comments as set forth in the previous response, the disclosure within the written description, and science. The reaction product of the oxetane monomers set forth in claim 35 with a mono or polyhydroxyl terminated hydrocarbon polymer results in a copolymer having an ether linkage between the blocks, *i.e.*, those formed from the oxetane monomers and the mono or polyhydroxyl terminated hydrocarbon polymer. This is an indisputable fact.

It is also indisputable that the copolymers taught by Hargis include first and second blocks that are connected via a urethane linkage. Therefore, while Applicants acknowledge that the patentability of claim 35 – which is a product by process claim – hinges on the resulting copolymer (not the method for making it), indisputable facts show that the copolymer resulting from the process described in claim 35 are structurally different than those copolymers taught by Hargis. As a result, the Examiner's rejection cannot be maintained.

RESTRICTION REQUIREMENT

The Applicants wish to first address paragraph 2 on page 3 of the Office Action. Therein, the Examiner restricted claim 61, and subsequently withdrew the claim from consideration, because the Examiner has found that claim 61 is directed to a process for preparing a block copolymer and that no process claims were originally claimed.

While the Applicants disagree with the Examiner and believe that a search of the particular process recited should have been conducted in examining the originally presented claims, especially in view of the fact that product by process claims were presented, the Applicants have cancelled claim 61 in an effort to expedite prosecution of the elected subject matter.

The Examiner has also restricted and subsequently withdrawn from further consideration claim 55 and the claims dependent thereon. Claim 55 is a product-by-process claim where an oxetane monomer is polymerized in the presence of a hydroxyl-terminated polymer. The Examiner suggests that the term “oxetane monomer” is broader than the definition originally set forth in the claims where the oxetane monomers had an ether side chain that was terminated by a fluorinated aliphatic group.

Claim 55 has been amended by including the recitation “where the oxetane monomer includes pendent ether groups that include, at the terminal portion thereof, a fluorinated aliphatic group.” Claim 58 recites that the fluorinated aliphatic group is a perfluorinated group, and claim 63 recites that the fluorinated aliphatic group is characterized by having at least 95% of the available hydrogen atoms replaced by fluorine.

Thus, the basis for the Examiner’s restriction requirement (*i.e.*, that the oxetane monomer was not fluorinated) is no longer factually true and therefore the restriction requirement cannot be maintained. Applicants further note that claim 35, which is not the subject of a restriction requirement, and which has been examined as evidenced at page 4 of this Office Action, is drafted in product-by-process form and therefore the fact that claim 55 is drafted in product-by-process form cannot serve as a basis for maintaining the restriction requirement.

ALLOWABLE SUBJECT MATTER

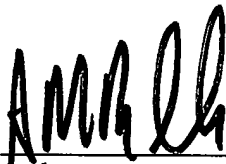
Applicant note that the Examiner has found claims 2-19, 44-54, and 62 to contain allowable subject matter.

CONCLUSION

In view of the foregoing amendments and arguments presented herein, the Applicants respectfully requests the Examiner reconsider the rejections provided in the last Office Action. A formal Notice of Allowance of claims 2-60 and 62-63 is earnestly solicited. Should the Examiner care to discuss any of the foregoing in greater detail, the undersigned attorney would welcome a telephone call.

No fees are believed due at this time, nonetheless, in the event that a fee required for the filing of this document is missing or insufficient, the undersigned attorney hereby authorizes the Commissioner to charge payment of any fees associated with this communication or to credit any overpayment to Deposit Account No. 07-1045.

Respectfully submitted,



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